

REMARKS

This Amendment responds to the Office Action dated April 16, 2003 in which the Examiner rejected claims 10-11 under 35 U.S.C. §112, second paragraph, rejected claims 5, 7, 10-12 and 15-16 under 35 U.S.C. §102(b) and rejected claims 6, 8-10 and 13-14 under 35 U.S.C. §103.

As indicated above, claims 10 and 11 have been amended in order to more particularly point out and distinctly the subject matter which the Applicants regard as the invention. It is respectfully submitted that the rejection to the claims under 35 U.S.C. §112, second paragraph no longer applies. Therefore, it is respectfully requested that the Examiner withdraws the rejection to the claims under 35 U.S.C. §112, second paragraph.

Claim 5 claims a method of holding an electronic part or a component constituting the electronic part. The method comprises the step of holding the electronic part or component constituting the electronic part on a surface of an elastic material, in which at least the surface of the elastic material is adhesive and conductive, by the adhesive strength of the surface.

Through method of the claimed invention holding an electronic part or component on an elastic material by the adhesive strength of the surface of the elastic material which is adhesive and conductive, as claimed in claim 5, the claimed invention provides a method of holding an electronic part in which the generation of electrostatic charge is prevented. The prior art does not show, teach or suggest the invention as claimed in claim 5.

Claim 6 claims a method of manufacturing electronic parts comprising the steps of first, holding a substrate on a surface of an elastic material, in which at least the surface of

the elastic material is adhesive and conductive, by the adhesive strength of the surface.

Next, an element is mounted and electrically connected on the substrate while the substrate is held on the surface of the elastic material.

Through the method of the claimed invention holding a substrate on a surface of an elastic material which is adhesive and conductive and then mounting and electrically connecting an element on the substrate, as claimed in claim 6, the claimed invention provides a method of manufacturing electronic parts in which the generation of electrostatic charge is prevented. The prior art does not show, teach or suggest the invention as claimed in claim 6.

Claim 7 claims a method of manufacturing electronic parts comprising the steps of first, holding a substrate on a surface of an elastic material, in which at least the surface of the elastic material is adhesive, by the adhesive strength of the surface. Next, an element is mounted and electrically connected on the substrate while the substrate is held on the surface of the elastic material.

Through the method of the claimed invention holding a substrate on a surface of an elastic material by the adhesive strength of the surface and then mounting and electrically connecting an element on the substrate as claimed in claim 7, the claimed invention provides a method of manufacturing electronic parts which prevents the generation of electrostatic charges. The prior art does not show, teach or suggest the invention as claimed in claim 7.

Claim 5 was rejected under 35 U.S.C. §102(b) as being anticipated by *Tatsufumi et al.* (Japanese reference 62-244142).

Applicants respectfully traverse the Examiner's rejection of the claim under 35 U.S.C. §102(b). The claim has been reviewed in light of the Office, and for reasons which will be set forth below, it is respectfully requested that the Examiner withdraws the rejection to the claim and allows the claim to issue.

Tatsufumi et al. appears to disclose a method of forming an electrical connection with a semiconductor device. The method includes the steps of placing an anisotropic conductive adhesive layer between a semiconductor device and a support. The anisotropic conductive paste is prepared by disbursing a conductive, elastometric powder into a synthetic resin binder. The semiconductor device has an aluminum electrode and a gold bump disposed on the aluminum electrode. The support has an electrode that opposes the electrode of the semiconductor device. Heat and pressure are applied to the rear face of the semiconductor device so as to connect and fix the gold bump of the semiconductor to the electrode of the support.

Attached to this amendment is a translation of *Tatsufumi et al.*

Thus, it is clearly disclosed in *Tatsufumi et al.* that the anisotropic conductive adhesive layer, which is formed between the semiconductor device and support, is merely placed between the gold bump of the chip and the electrode of the support to connect the bump to the support. Nothing in *Tatsufumi et al.* shows, teaches or suggests holding an electronic part or component by the adhesive strength of the surface of an elastic material which is adhesive and conductive as claimed in claim 5. Rather, the conductive filler in *Tatsufumi et al.* is merely used to connect the gold bump to the support and not to hold the electronic part by the adhesive strength of its surface.

Furthermore, *Tatsufumi et al.* merely discloses connecting and fixing the gold bump of the semiconductor device to the electrode of the support by applying heat and pressure to the rear face of the semiconductor device. Thus, *Tatsufumi et al.* clearly teaches away from the claimed invention and does not hold the electronic part by the adhesive strength of the support. Instead, due to the connection of the gold bump to the electrode of the support, the chip and support are connected in *Tatsufumi et al.*

Since nothing in *Tatsufumi et al.* shows, teaches or suggests holding an electronic part by an adhesive strength of a surface of an elastic material which is conductive and adhesive as claimed in claim 5, it is respectfully requested that the Examiner withdraws the rejection to claim 5 under 35 U.S.C. §102(b).

Claims 7, 10-12 and 15-16 were rejected under 35 U.S.C. §102(b) as being anticipated by *Kazuhiko et al.* (Japanese reference JP 07-022795).

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. §102(b). The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, it is respectfully requested that the Examiner withdraws the rejection to the claims and allows the claims to issue.

Kazuhiko et al. appears to disclose a SUS-made metal flat board 2 which is coated uniformly with an adhesive silicone rubber layer 1. A thin board 3 is flattened and fixed to the metal flat board 2 by the adhesive force of the adhesive silicone rubber layer 1. As the flat board to be used, a metal flat board, a plastic flat board, a ceramic flat board or the like is enumerated.

Thus, *Kazuhiko et al.* merely discloses fixing a thin board 3 to a metal flat board 2 by an adhesive force of an adhesive silicone rubber layer 1. Nothing in *Kazuhiko et al.* shows, teaches or suggests mounting and electrically connecting an element on a substrate while the substrate is held on a surface of an elastic material as claimed in claim 7. Rather, *Kazuhiko et al.* merely discloses fixing a thin board 3 to a flat board 2 by an adhesive force of a rubber layer 1.

Since nothing in *Kazuhiko et al.* shows, teaches or suggests mounting and electrically connecting an element on a substrate while the substrate is held on a surface of an elastic material as claimed in claim 7, it is respectfully requested that the Examiner withdraws the rejection to claim 7 under 35 U.S.C. §102(b).

Claims 10-12 and 15-16 depend from claim 7 and recite additional features. It is respectfully submitted that claims 10-12 and 15-16 would not have been anticipated by *Kazuhiko et al.* at least for the reasons as set forth above. Therefore, it is respectfully requested that the Examiner withdraws the rejection to claims 10-12 and 15-16 under 35 U.S.C. §102(b).

Claims 6, 9 and 10 were rejected under 35 U.S.C. §103 as being unpatentable over *Kazuhiko et al.* in view of *Oehmke* (U.S. Patent No. 4,098,945).

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. §103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, it is respectfully requested that the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, *Kazuhiko et al.* merely discloses fixing a thin board 3 to a metal flat board 2 by an adhesive force of an adhesive silicone rubber layer 1. Nothing in *Kazuhiko et al.* shows, teaches or suggests a) an elastic material is adhesive and conductive or b) mounting and electrically connecting an element on the substrate while the substrate is held on the surface of the elastic material as claimed in claim 6. Rather, *Kazuhiko et al.* merely discloses fixing a thin board 3 to a metal flat board 2 by an adhesive force of an adhesive silicone rubber layer.

Oehmke appears to disclose a soft conductive material which is electrically conductive. The compositions are useful for a wide variety of applications which include peelable adhesive fastening of metallic materials without the interruption an electrical conductive pathway between them, stick-on anode protection strips composed of the adhesive on an active metal foil, grounding tapes, fastening sacrificial anodes to metallic objects to protect them from corrosion, making soft conductive gaskets and rollers, adhesively fastening metal objects together without breaking the electrical paths through them, etc.

Thus, *Oehmke* merely discloses a soft conductive material which is electrically conductive. However, nothing in *Oehmke* shows, teaches or suggests that the material can hold a substrate on its surface by the adhesive strength of its surface. Rather, *Oehmke* merely discloses a soft conductive composition.

Additionally, nothing in *Oehmke* shows, teaches or suggests mounting and electrically connecting an element on the substrate while the substrate is held on the surface

of the elastic material as claimed in claim 6. Rather, *Oehmke* merely discloses a soft conductive composition.

The combination of *Kazuhiko et al.* and *Oehmke* would merely suggest to fix the thin board 3 to the metal flat board 2 of *Kazuhiko et al.* by replacing the adhesive silicone rubber layer 1 of *Kazuhiko et al.* with the soft conductive composition of *Oehmke*. However, nothing in the combination shows, teaches or suggests mounting and electrically connecting an element on the substrate while the substrate is held on the surface of the elastic material as claimed in claim 6. Therefore, it is respectfully requested that the Examiner withdraws the rejection to claim 6 under 35 U.S.C. §103.

Claims 9 and 10 depend from claim 6 and recite additional features. It is respectfully submitted that claims 9 and 10 would not have been obvious within the meaning of 35 U.S.C. §103 over *Kazuhiko et al.* and *Oehmke* at least for the reasons as set forth above. Therefore, it is respectfully requested that the Examiner withdraws the rejection to claims 9 and 10 under 35 U.S.C. §103.

Claim 13 was rejected under 35 U.S.C. §103 as being unpatentable over *Kazuhiko et al.* in view of Applicants admitted prior art and claims 8 and 14 were rejected under 35 U.S.C. §103 as being unpatentable over *Kazuhiko et al.* in view of *Matsushita* (Japanese Reference 11-045912).

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. §103. The claims have been reviewed in light of the Office Action and for reasons which will be set forth below, it is respectfully requested that the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in *Kazuhiko et al.* shows, teaches or suggests the primary features as discussed above, it is respectfully submitted that the combination of the primary reference of *Kazuhiko et al.* with the secondary references will not overcome the deficiencies of the primary reference. Therefore, it is respectfully requested that the Examiner withdraws the rejection to claims 8, 13 and 14 under 35 U.S.C. §103.

As indicated above, new claim 17 has been added. It is respectfully submitted that claim 17 is also in condition for allowance.

The prior art of record, which is not relied upon, is acknowledged. The references taken singularly or in combination do not anticipate or make obvious the claimed invention.

Thus it now appears that the application is in condition for reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

If for any reason Examiner feels that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our
Deposit Account No. 02-4800.

Respectfully submitted,

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